1 of 3

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Kenya T. Pierre — 50,165
Name of Attorney — Registration No.

Signature of Attorney

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of	:	
THOMAS E. RABE, ET AL.	:	Confirmation No.: 4129
Serial No. 09/629,734	:	Group Art Unit: 1617
Filed: July 31 2000	:	Examiner: Edward Webman
Title: ELECTROSTATICALLY-SPRAYABLE	:	
TOPICAL COMPOSITIONS HAVING	:	
INSULATING EXTERNAL PHASE AND	:	
CONDUCTIVE INTERNAL PHASE	:	

APPEAL BRIEF

Commissioner for Patents
Washington, D.C. 20231

Dear Sir,

This Appeal Brief is submitted in support of the Notice of Appeal filed on February 11, 2003, setting a two month period for response. A petition to extend the period for response two months is being submitted herewith.

REAL PARTY IN INTEREST

The real party in interest is The Procter & Gamble Company of Cincinnati, Ohio. The Inventors Thomas Elliot Rabe, Helen Shu Ying Yen, June Turkanis Brennock, and Caroline Becque Martello assigned their interest to The Procter & Gamble Company which was recorded on August, 16, 2001, reel 11864, frame 487.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to the Appellants, or known to Appellants' legal representative that will directly affect, will be directly affected by, or will have a bearing on the Board's decision in the present appeal.

STATUS OF CLAIMS

Claims 1-7 and 10-21 are pending and stand rejected. A copy of these claims, which are being appealed, appear in the Appendix.

STATUS OF AMENDMENTS

In response to the Non-final Office Action dated January 29, 2002, Appellants amended Claims 4-6 and 17-20. In the Final Office Action of August 13, 2002, the Office withdrew Claims 8, 9, 22 and 23 from consideration. In response to the Final Office Action, Appellants amended Claim 1. The Office has indicated that upon the filing of this appeal, the proposed amendment will be entered.

SUMMARY OF THE INVENTION

The present invention as elected relates to a method of treating skin comprising electrostatically spraying an emulsion composition onto the skin, wherein the emulsion comprises: a) from about 5% to about 75% of an insulating external phase comprising one or more liquid insulating materials; and b) from about 15% to about 80% of a conductive internal phase comprising one or more conductive materials. Applicants have surprisingly found that the claimed emulsion compositions are capable of being electrostatically sprayed to skin for treatment of the skin.

ISSUES

AppellantS present the following issues for consideration on appeal:

I. Under 35 USC §103, do the general disclosures of the cited references provide the motivation necessary to combine and motivate a skilled artisan to arrive at the presently claimed invention?

GROUPING OF CLAIMS

Claims 1-7 and 10-21 stand or fall together.

ARGUMENTS

In the Office Action dated August 13, 2002, the Office rejected Claims 1-7 and 10-21 under 35 USC§103 (a) as being unpatentable over Barnett et al., USP No. 5,494,674 (hereinafter "Barnett") in view of Masuda, WO 98/26752 (hereinafter "Masuda"). The Office states that Barnett teaches an electrostatic spraying system for skin treatment agents while not teaching an emulsion composition containing volatile silicones. Therefore, the Office relies on Masuda as teaching an emulsion composition comprising up to about 90% of volatile silicones as an external phase and up to about 30% of propylene glycol as an internal phase. Based on Masuda's additional teachings of emulsifiers and silicone viscosities under 10,000 cSt, the Office believes that it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to deliver the composition of Masuda to achieve the beneficial effect of cost effectiveness, safety, and evenness of coverage on the skin surface during application by using an electrostatic spray in view of Barnett.

In view of the foregoing, the Office is of the opinion that the claimed invention is clearly obvious in view of the prior art.

For the reasons that will be set forth below, Appellant submits that Claims 1-7 and 10-21 are nonobvious over and patentably distinct from the cited references. Thus, the Board should reverse the Examiner's rejections. Accordingly, the favorable action by the Board is respectfully requested.

I. Claims 1-7 and 10-21 are not obvious in view of the cited references under 35 USC §103(a) because the references fail to teach or suggest Appellant's electrostatic spraying of an emulsion and there is no motivation or desire to combine the references to do so.

Appellants respectfully submit that the claimed invention would not have been obvious over the cited references. Barnett discloses a system for delivering skin treatment agents to the skin. More particulary, the disclosed invention relates to methods and apparatus for applying such agents onto the skin using the principle of electrostatic spraying. As indicated by the Office, the reference fails to teach or suggest that emulsion compositions could be electrostatically applied to skin as presently claimed. In fact, the reference teaches away from more complex compositions like emulsions since it teaches that the inclusions of "stabilizing ingredients such as surfactants, polymers, preservatives, etc" could lead to poor sensory property like stickiness, greasiness, or irritation. *See*, col. 1, lines 26-31 of Barnett. Emulsions, therefore, would not be deliverable nor beneficial in the Barnett composition as indicated by the Office. Thus, one skilled

in the art reading Barnett would have been led away with no desire to arrive at the present invention alone or in combination with Masuda.

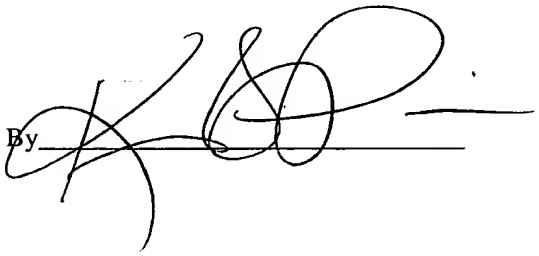
Masuda does not remedy the shortcoming of Barnett. Rather, Masuda discloses a water-in-oil emulsion foundation wherein the aqueous internal phase comprises: a) from about 0.1 % to about 10 % by weight of the foundation, of a water soluble or dispersible polymer; b) from about 0.5 % to about 30 % by weight of the foundation, of a plasticizing solvent; and c) from about 1 % to about 30 % by weight of the foundation, of an ultra fine titanium dioxide-water dispersion. The ultra fine titanium dioxide-water dispersion comprises from about 0.2 % to about 18 % by weight of the foundation of an ultra fine titanium dioxide, and from about 0.002 % to about 7.2 % by weight of the foundation of a nonionic surfactant. There is no teaching or suggestion found in this secondary reference of the invention that is claimed by Appellants which includes the **electrostatic spraying of an emulsion** comprising from about 5% to about 75% of an insulating external phase comprising one or more liquid insulating materials and from about 15% to about 80% of a conductive internal phase comprising one or more conductive materials. Appellants, therefore, respectfully assert that a skilled artisan reading the cited references would not have attempted to arrive at the present invention since Barnett teaches away from emulsion-type or complex compositions being electrostatically sprayed and Masuda discloses nothing that reverses this deviation from Appellants' invention. The Office attempts to remedy these shortcomings by asserting that Masuda teaches the optional inclusion of stabilizers. Appellants respectfully submit that the *optional* inclusion of an ingredient taught by one reference cannot be combined with another reference that diverges from the inclusion of such ingredient. To do so would be an inappropriate use of hindsight which is not a justifiable basis for a rejection under 35 USC §103. Based on the failed teachings of both references to arrive at the claimed invention, Appellants assert that the rejection of claims 1-7 and 10-21 is improper. Thus, withdrawal of the rejection and reconsideration of the claims is earnestly requested.

It is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the Applicants' invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. *See, SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. *In re Grabiak*, 222 USPQ2d 870, 872 (Fed. Cir. 1985). Furthermore, "obvious to

try" is not a valid test of patentability. *In re Dow Chemical Co.*, 5 PQ2d 1529 (CAFC 1988); *In re Antonie*, 195 USPQ 6 (CCPA 1977). There must be a suggestion or teaching that the claimed novel form could or should be prepared. *In re Cofer*, 148 USPQ 268 (CCPA 1966). Moreover, it is well settled that obviousness cannot be established by a combination of references where one of the references teaches away from the claimed invention. *In re Grasselli*, 281 USPQ 769, 780 (Fed. Cir. 1983).

SUMMARY

For the above reasons, Appellants respectfully submit that the rejection by the Office of Claims 1-7 and 10-21 as unpatentably obvious under 35 USC §103(a) is improper. A reversal by the Board of the Examiner's rejection is, therefore, respectfully requested.



T.E. RABE ET AL.

By_____

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June 11, 2003
Customer No. 27752

APPENDIX

Appealed Claims: Serial No. 09/629,734

1. A method of topically applying a topical emulsion composition comprising electrostatically spraying an emulsion composition onto the skin, wherein the emulsion comprises:

a) from about 5% to about 75% of an insulating external phase comprising one or more liquid insulating materials; and

b) from about 15% to about 80% of a conductive internal phase comprising one or more conductive materials.

2. A method according to claim 1 wherein the composition comprises from about 15% to about 70% of the insulating external phase and from about 20% to about 75% of the conductive internal phase.

3. A method according to claim 1 wherein the composition comprises from about 20% to about 60% of the insulating external phase and from about 30% to about 70% of the conductive internal phase.

4. A method according to claim 1 wherein the weight ratio of insulating external phase to conductive internal phase is about 0.2:1 to 8:1.

5. A method according to claim 1 wherein the insulating external phase has a viscosity of about 10,000 cSt or less.

6. A method according to claim 1 wherein the insulating material of the external phase is selected from the group consisting of volatile silicones, volatile hydrocarbons, and mixtures thereof.

7. A method according to claim 6 wherein the insulating material comprises a cyclic polyalkylsiloxane having the formula $[SiR_2\text{-}O]_n$ wherein R is methyl and n is an integer of from about 4 to about 6.

10. A method according to any of the preceding claims wherein the conductive internal phase comprises one or more liquid conductive materials.

11. A method according to claim 10 wherein the conductive material of the internal phase is selected from the group consisting of water, alcohols, glycols, polyols, ketones and mixtures thereof.

12. A method according to claim 10 wherein the conductive material of the internal phase is selected from the group consisting of alcohols, glycols, polyols and mixtures thereof.

13. A method according to claim 10 wherein the conductive material of the internal phase is selected from the group consisting of propylene glycol, butylene glycol, dipropylene glycol, phenyl ethyl alcohol, ethanol, isopropyl alcohol, glycerin, 1,3-butanediol, 1,2-propane diol, isoprene glycol, water, acetone, and mixtures thereof.

14. A method according to claim 10 wherein the conductive material of the internal phase is selected from the group consisting of propylene glycol, butylene glycol, ethanol, glycerin, water, and mixtures thereof.

15. A method according to claim 10 wherein the conductive material of the internal phase is selected from the group consisting of propylene glycol, ethanol, and mixtures thereof

16. A method according to claim 10 wherein the conductive material of the internal phase is propylene glycol.

17. A method according to claim 1 wherein the composition comprises about 35 weight % or less solids.

18. A method according to claim 1 wherein the composition comprises one or more ingredients selected from the group consisting of materials which impart film forming or substantive properties, powders, skin feel ingredients, emulsifiers, and structuring or thickening agents.

19. A method according to claim 1 wherein the composition is a cosmetic foundation.

20. A method according to claim 1 wherein the composition is electrostatically sprayed at a flow rate of from about 0.1 to about 100 ml/hr, a voltage of from about 1kV to about 20kV, and an application rate of from about 0.01 mg composition /cm^2 skin to about 12 mg composition /cm^2 skin.

21. A method according to claim 20 wherein the composition is electrostatically sprayed at a flow rate of from about 1 to about 30 ml/hr and a voltage of from about 6kV to about 20kV.

P&G Case 7730R

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For ELECTROSTATICALLY-SPRAYABLE TOPICAL COMPOSITIONS HAVING INSULATING EXTERNAL PHASE AND CONDUCTIVE INTERNAL PHASE

BRIEF ON APPEALS

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed, pursuant to 37 C.F.R. 1.192(a), is Appellant's brief on Appeal for the above application. The Brief is being forwarded in triplicate.

Please charge the fee of $320.00 pursuant to 37 C.F.R. 1.17(c) to Deposit Account No. 16-2480 for the filing of the brief in support of an appeal. The Commissioner is also authorized to charge any additional fees which may be required to this account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

By _____
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Date: June 11, 2003

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(BriefonAppealTrans.doc)
(Last Revised 4/3/2003)